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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,173	01/27/2000	Hideki Ito	2298/3	9525

7590 07/30/2003

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EXAMINER
PATTERSON, MARC A

ART UNIT	PAPER NUMBER
1772	19

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

A 8-19

Advisory Action	Application No.	Applicant(s)	
	09/492,173	ITO ET AL.	
	Examiner	Art Unit	
	Marc A Patterson	1772	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.☒ The proposed amendment(s) will not be entered because:

(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see Note below);

(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3.☐ Applicant's reply has overcome the following rejection(s): _____.

4.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.☐ The a)☐ affidavit, b)☐ exhibit, or c)☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

6.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: *none*.

Claim(s) objected to: *none*.

Claim(s) rejected: *7-29*.

Claim(s) withdrawn from consideration: *none*.

8.☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9.☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10.☒ Other: *See attached.*

ADVISORY ACTION

Applicant's arguments filed June 30, 2003 have been fully considered but have not been found to be persuasive.

1. Applicant argues, on page 8 of Paper No. 19, that the rejection is improper because the claimed invention defines adhesive retention for the claimed film as being defined by a process comprising applying 1,3 – dioxolane to a width of 2 mm on one side of a sample film at a first edge rolling the sample film into a tubular film, bonding the first edge onto the opposite edge to form a tubular label, and heat shrinking the label onto metal cylinder at a temperature of 200 degrees Celsius for 2 seconds. However, the claims prior to amendment were not directed to a process comprising applying 1,3 – dioxolane to a width of 2 mm on one side of a sample film at a first edge rolling the sample film into a tubular film, bonding the first edge onto the opposite edge to form a tubular label, and heat shrinking the label onto metal cylinder at a temperature of 200 degrees Celsius for 2 seconds, nor were the claims directed to a film having an adhesive retention.. The amendment therefore raises new issues, which to be completely addressed would require further search and consideration, and the amendment therefore has not been entered. Even if the amendment was entered, the amended claim would not overcome the rejection because the adhesive retention appears to be directed to a desired result of the invention (no peeling after heat shrinking to a metal container) rather than a structural limitation or physical property which can be claimed.

Applicant argues, on page 8 of Paper No. 19, that the rejection is improper because the claimed invention defines preform defect finish percentage for the claimed film as being defined by a process comprising applying 1,3 – dioxolane to a width of 2 mm on one side of a sample

film at a first edge rolling the sample film into a tubular film, bonding the first edge onto the opposite edge to form a tubular label, and heat shrinking the label onto metal cylinder at a temperature of 200 degrees Celsius for 2 seconds. However, the claims prior to amendment were not directed to a process comprising applying 1,3 – dioxolane to a width of 2 mm on one side of a sample film at a first edge rolling the sample film into a tubular film, bonding the first edge onto the opposite edge to form a tubular label, and heat shrinking the label onto metal cylinder at a temperature of 200 degrees Celsius for 2 seconds. The amendment therefore raises new issues, which to be completely addressed would require further search and consideration, and the amendment therefore has not been entered. Even if the amendment was entered, the amended claim would not overcome the rejection because the preform defect finish percentage appears to be directed to a desired result of the invention (no creasing or jumping after heat shrinking to a metal container) rather than a structural limitation or physical property which can be claimed.

Applicant also argues, on page 9, that the shrinkage obtained in experiments for Fukuda is 49%, which is well outside the claimed range of 10 – 40%. However, Fukuda et al disclose a shrinkage of not more than 15 in water at 85 degrees Celsius (column 4, lines 44 – 51). Therefore, the shrinkage would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end use of the product. It therefore would be obvious for one of ordinary skill in the art to vary the shrinkage, since the shrinkage would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Fukuda, in the absence of unexpected results. *In re Boesch and Slaney, 205 USPQ 215 (CCPA 1980).*

In addition, the claimed invention has not been rejected as being unpatentable over Fukuda alone, but over Fukuda in view of Shibuya; it is Shibuya which teaches a heat shrinkable composition comprising a blend of a non – elastomeric polyester and an elastomeric polyester, as discussed on page 2 of the previous Action, and no data have been obtained for Shibuya.

Applicant also argues on page 9 that there would be no motivation to combine Fukuda with Shibuya because their teachings may be contrary to each other; Shibuya teaches enhancement of cold resistance, Applicant argues, whereas Fukuda teaches warm water resistance, sufficient shrinkage and solvent resistance. However, the properties of warm water resistance and cold resistance are not necessarily contrary; furthermore, as stated on page 2 of the previous Action, Shibuya et al teach a composition comprising 50 weight percent to 99.9 weight percent thermoplastic polyester resin and 0.1 weight percent to 50 weight percent polyester resin in a heat shrinkable polyester film for the purpose of making a heat shrinkable film having superior gas barrier property. The desirability of providing for a blend of a non – elastomeric polyester and an elastomeric polyester in Fukuda, which is a heat – shrinkable film, would therefore be obvious to one of ordinary skill in the art.

One of ordinary skill in the art would therefore have recognized the advantages of providing for a composition comprising 50 weight percent to 99.9 weight percent thermoplastic polyester resin and 0.1 weight percent to 50 weight percent polyester resin in Fukuda et al.

Conclusion

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Patterson, whose telephone number is (703) 305-3537. The

examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (703) 308-4251. FAX communications should be sent to (703) 872-9310. FAXs received after 4 P.M. will not be processed until the following business day.

Marc A. Patterson, PhD.

Art Unit 1772

NASSER AHMAD
PRIMARY EXAMINER